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09/412,147 10/05/99 EGGLESTON

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EXAMINER

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ART UNIT

PAPER NUMBER

2164

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/412,147

Applicant(s)

EGGLESTON ET AL.

Examiner

Frantzy Polnvil

Group Art Unit

2768



☒ Responsive to communication(s) filed on Oct 5, 1999

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-38 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-38 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-3, 6, 10-15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Storey.

As per claims 1-3, Storey discloses a fully integrated online interactive frequency and award redemption system. The system comprises a host computer connected to a network; a database of the host computer (note figure 2 of the drawings); and an application program for participation in incentive programs of a plurality of independent providers (note column 3, line 61 to column 4, line 10).

As per claim 10, Storey discloses having more than one programs whereby different companies manage different incentive programs. Note column 4, lines 3-10.

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Claims 6 and 11 contain limitations addressed in claim 1 and these limitations are rejected under a similar rationale. As per the claimed database of awards associated with the incentive program, applicant is directed to column 4, lines 1-26. As per an application program for automating the fulfillment for the incentive program, applicant is directed to column 7, line 45 to column 8, line 54.

As per claim 12, Storey discloses having a plurality of companies having different incentive programs. Note column 4, lines 3-27. The awards are stored in award database.

As per claim 13, note column 4, lines 3-27.

As per claim 14, applicant is directed to the rejection of claim 7 above.

As per claim 15, note column 8, lines 17-41.

As per claim 17, note also column 5, lines 36-42.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-22 and 33-34 are rejected under 35 USC 103(a) in view of Storey.

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The teachings of Storey are discussed above. The system also comprises a user located remotely (thus a client computer of a consumer or user is present for accessing the system. Note column 2, lines 54-65. The system also comprises a server for the host computer (note figure 1) and a web site located on the server of the host computer wherein the consumer may participate in incentive programs of the plurality of independent providers via the web site. Note also column 2, lines 54-65 wherein it is described that the user accesses the system via the Internet or Netscape or CompuServe thus implying accessing providers' websites.

As per claim 4, the system comprises a user computer and a server or host computer therefore, a computer network having a first and a second workstation and being capable of transferring electronic data between the workstation wherein the first workstation is the host computer (note figure 1);

providing each of the workstation with an application program capable of responding to input from the first workstation or the second workstation (note column 3, lines 1-61);

allowing a user at the first workstation or user computer to operate the application program to generate an incentive program that is stored as an electronic file on the first workstation (column 3, line 7 to column 4, line 52);

transferring the electronic file to the second workstation and providing an address for such file to permit access to such file from a computer network would have been obvious to the skilled artisan since it is noted that the user accesses and retrieves award information from the host computer.

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As per claim 5, note column 2, lines 15-27; column 4, lines 11-26 and column 10, lines 3-6 of Storey.

As per claim 7, Storey does not explicitly teach providing a card for fulfillment of awards won in the incentive program. The Examiner takes official Notice that different types of cards such as magnetic cards and smart cards are usually given to consumers for holding fulfillment data and prizes won. It would have been obvious to one of ordinary skill in the art at the time of the invention to introduce such a feature in Storey with the motivation of providing users with a device to redeem prizes at selected stores.

As per claim 8, Storey discloses that a user inputs his personal identification number. Note column 6, lines 44-47. Having a memory for storing the user's PIN would have been obvious to the skilled artisan for correlation with stored PINs and also to prevent unauthorized access to the system.

As per claim 9, note column 5, lines 36-42.

As per claim 16, Storey discloses that a user inputs his personal identification number. Note column 6, lines 44-47. Having a memory for storing the user's PIN would have been obvious to the skilled artisan for correlation with stored PINs and also to prevent unauthorized access to the system. Storing the PIN in a memory card would have been obvious to the skilled artisan to enable authorized usage of the card.

As per claim 18, Storey discloses a fully integrated on-line interactive frequency and award redemption program. The system comprises having different companies accessing the

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system such as a host computer for managing different incentive programs. Note column 4, lines 3-27. Although a sponsor computer is not explicitly shown in the figures, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a sponsor computer in the system of Storey so that sponsors may remotely access the host and make desired changes by interacting with an incentive application program, thereby lifting the administrative burden from the host system. The system of Storey also includes a host computer connected to a network and the host computer having a server, and an incentive application program running on the server. Note figure 1 of Storey.

As per claim 19, Storey discloses an award code (column 9, lines 62-67). Classifying the code in numbers that represent the element of the code is not explicitly stated. Such would have been obvious to the skilled artisan in the system of Storey with the motivation of easily distinguishing the awards. Then a generator application program for generating tables of the numbers that represent the code for the incentive program would have been obvious to the skilled artisan with the motivation of making the codes instantly distinguishable to consumers.

As per claim 20, the system of Storey comprises an award association application program for associating an award with an incentive program.

As per claim 21, the system of Storey does not explicitly comprise a game piece associate with the incentive application program wherein the game piece comprises a branded image of a provider of an incentive program. The Examiner takes Official Notice that games are well known incentive programs that companies use to promote products and to provide discounts to

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customers for purchasing certain products. Having a game piece comprising a branded image of a provider of an incentive program in the system of Storey would have been obvious to the skilled artisan with the motivation of bringing more excitement to a user using the system and also to encourage customers' loyalty.

As per claim 22, applicant is directed to column 10, lines 1-6 of Storey.

As per claim 23 applicant is directed to the rejection of claim 19 above.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

5. Claims 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldhaber et al..

As per claim 27, the system of Goldhaber et al comprises a computer capable of running an application program and an incentive program running on the computer. Note column 7, lines 21-67 of Goldhaber et al. Objects associated with an incentive program wherein the object being associated with an action that is associated with the incentive program is also taught on column 7, lines 21-67 of Goldhaber et al. The system also comprises a graphical image file or CyberCoin that is displayed in connection with the object. Note also column 7, lines 21-67 of Goldhaber et al.

As per claim 28, the graphical image file in Goldhaber et al includes branded images.



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As per claim 29, Goldhaber's system includes game pieces in an incentive program. Note also column 7, lines 21-67.

As per claim 30, note column 11, lines 8-24 of Goldhaber et al.

6. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al.

As per claim 31, Goldhaber does not explicitly recite the graphical image file may change. It would have been obvious to one of ordinary skill in the art at the time of invention to modify or change the graphical image file with the motivation of introducing different games to the users or customers thus making the system more attractive.

As per claim 32, the displayed graphical image file depends on characteristics of the user. Note column 8, lines 2-18 of Goldhaber et al.

7. Claims 24-26, 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garloff et al. in view of Storey.

As per claim 24, Garloff et al discloses a method and apparatus for a fully inherited object-oriented computer source code from user-entered specifications. The system comprises a database of objects associated with parameters and an interface of the builder application for user entry of parameters for a given program. Note column 12, lines 20-67 of Garloff et al.

Associating an object with each parameter entered is also taught on column 3, lines 1-20 and column 12, lines 20-67 of Garloff et al. Generating a program comprising the objects associated with parameters are within the scope of Garloff et al. Garloff et al is not directed toward a

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specific program such as an incentive program. Incentive programs techniques are found in Storey. Note the abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the incentive techniques of Storey into Garloff et al in order to provide an incentive program builder application. The motivation would have been to instantly create an incentive program on line by a qualified sponsor.

As per claims 25-26, Storey discloses an award code (column 9, lines 62-67). Classifying the code in numbers that represent the element of the code is not explicitly stated. Such would have been obvious to the skilled artisan in the system of Storey with the motivation of easily distinguishing the awards. Then a generator application program for generating tables of the numbers that represent the code for the incentive program would have been obvious to the skilled artisan with the motivation of making the codes instantly distinguishable to consumers.

Claims 35 and 37 contain features addressed in claims 24-32 and therefore are rejected under a similar rationale.

8. Claims 36 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garloff et al and Storey in further in view of Goldhaber et al.

The teachings of Garloff and Storey are discussed above. Storey and Garloff fail to teach a graphic image file being a branded image that may change depending on characteristics of the user. Goldhaber et al discloses providing graphical images of incentives to consumers. Moreover, game pieces in incentive programs are well known and well practiced in the art. It would have been obvious to one of ordinary skill in the art at the time of the invention to

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incorporate this feature into the combination of Garloff, Storey and Goldhaber et al in order to attract customers in the overall system.

9. Claims 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Storey in view of Goldhaber et al.

The teachings of Storey are given above. As per claims 33 and 34, these claims contain limitations addressed in claims 18 and 22 and these limitations are addressed likewise. Claim 33 additionally recites an award association application program. This feature is taught on column 10, lines 8-38 of Goldhaber et al. Fulfillment application program for associating a fulfillment method is not explicitly taught by Goldhaber et al. Storey discloses an on-line interactive frequency and award redemption program. Note the abstract and column 10, lines 1-6 of Storey. It would have been obvious to one of ordinary skill in the art to introduce the teachings of Storey into Goldhaber et al with the motivation of maintaining an account of users balance and transactions.

3.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil, whose telephone number is (703) 305-9779. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 5:00 PM.

The fax phone number for this Art Unit is (703) 308-5357.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

FP  
26Sep00



**Frantzy Poinvil**  
**Primary Examiner**  
**Art Unit 2768**